

REMARKS

Claims 1-5 and 9 are pending in the application, and are rejected.

Impropriety of Finality of the Office Action

The Examiner has introduced a new ground of rejection in this office action, detailed below. Therefore, the finality of the office action is improper, and Applicants should be entitled to a new, non-final office action. Applicants therefore submit the following remarks as if this present office action were properly a non-final office action.

Claim Rejections - 35 U.S.C. §112

Claims 1-5 and 9 are rejected under 35 U.S.C. §112, first paragraph, because the Examiner asserts that the specification, while being enabling “for an aqueous polymeric material coating layer wherein the polymeric material may be styrene-methacrylic acid ester-acrylic acid ester copolymer, ethylene-acrylic acid ester copolymer, methacrylic acid methyl-butadiene copolymer, styrene-butadiene copolymer and butadiene polymer”, does not provide enablement for the large or infinite number of polymeric material not including a fluorocarbon resin (other than the ones mentioned above). The Examiner asserts that the present claim language encompasses any aqueous polymeric material other than fluorocarbon resins and the polymeric binding agent.

With respect to the propriety of the 112 1st paragraph rejection

As stated in the Manual of Patent Examining Procedure (MPEP) §706.07, 1st and 2nd paragraphs, “Before a final rejection is in order, a clear issue should be developed between the examiner and the applicant....” Further, the MPEP states that second or subsequent actions on the merits

“shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement....”

The rejected claims have been pending since entry of the RCE dated December 13, 2004. Moreover, the rejected clauses of the claims have been pending essentially unchanged since June 29, 2001, the filing date of the present invention.

The present rejection under 35 U.S.C. §112, first paragraph is newly presented by the Examiner. The Examiner did not raise this rejection in his Office Action dated June 18, 2003, Office Action dated August 27, 2004 or the Office Action dated February 25, 2005. The present rejection of the claims is not necessitated by Applicant’s amendment, nor is the rejection based on information submitted in an Information Disclosure Statement.

Therefore, Applicants submit that to raise such a rejection in a Final office action is improper, and the finality of the office action should be withdrawn.

With respect to the substance of the 112 1st paragraph rejection

The Examiner states that “It is noted that fluorocarbon resins can be considered a minority group of species within the all-encompassing and broad group of non-fluorocarbon resin compounds.”

Applicants disagree with the statement that fluorocarbon resins can be considered a minority group within broad group of non-fluorocarbon resin compounds.

Applicants note the specification, page 5, lines 5-14 teach that, “Examples of the above-mentioned polymeric material to form the coating layer includes a copolymer comprising at least two types of elements selected from the group consisting of acrylic acid ester, methacrylic acid ester, aromatic olefin, conjugated diene and olefin. Specifically, styrene-methacrylic acid ester-acrylic acid ester copolymer, ethylene-acrylic acid ester copolymer, methacrylic acid methyl-butadiene copolymer, styrene-butadiene copolymer and the like can be employed. Furthermore, a rubber material such as butadiene polymer can be employed.”

Applicants submit that the claims are read in light of the specification. Applicants have listed a non-exhaustive list of specific polymeric materials in the specification. Therefore, the claims would be read by one skilled in the art to read on those specifically introduced polymeric materials, and their known and logical equivalents. Applicants respectfully submit that the claims are clearly defined and supported.

Claim Rejections - 35 U.S.C. §112, second paragraph

Claims 1-5 and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner asserts that claim 1 is indefinite because the negative limitation “wherein an aqueous polymeric material not including a fluorocarbon resin” is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.

As noted in Applicants’ previous responses, Applicants strongly disagree with this statement, and submit that the Examiner is not correct. Applicants note that the Examiner refers to MPEP §2173.05(i) Negative Limitations, which recites that there is nothing inherently ambiguous or uncertain about a negative limitation; as long as the boundaries of the patent protection sought are set forth definitely, *albeit negatively*, the claim complies with the requirements of 35 U.S.C. §112, second paragraph. Applicants therefore maintain their traverse of this rejection.

Applicants note the Examiner’s clarification of his reasons for his rejection above, and his statement that he has now substituted the rejection under 112, first paragraph instead of the rejection under 112, second paragraph. Nevertheless, because this rejection under 112, second paragraph appears to contradict the Examiner’s retraction of the rejection, Applicants reassert their traversal thereof.

Claim Rejections - 35 U.S.C. §102

Claims 1-5 and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by Yuasa et al. (U.S. Patent No. 5,250,369).

Applicants maintain their disagreement with this rejection, as further detailed hereinbelow.

The Examiner further asserts that although Applicants claim “an aqueous polymeric material”, the hydrophobic FEP of the cited reference is still read upon by the claim because Applicants do not stipulate the degree of aqueousness.

Applicants disagree with this rejection. Applicants submit that one skilled in the art would recognize an aqueous polymer from a nonaqueous polymer, and would immediately know that polyethylene could never be confused as an aqueous polymer. Applicants submit that Yuasa et al. does not teach or suggest a hydrogen absorbing alloy electrode ...coated with an aqueous polymeric material not including a fluorocarbon resin.

With respect to the Examiner’s assertion that Yuasa et al. teaches in column 14, lines 26-30 that polyethylene may be replaced with ABS, Applicants note that this statement does not apply to Example 7, which includes a polyethylene coating. Instead, this passage applies to a modification of the “further battery” described in column 14, lines 11 to 26. In that “further battery” example, an electrode was covered with a *mixture* of polyethylene and FEP in a 1:2 ratio. The subsequent passage referred to by the Examiner suggests that some of the polyethylene would be replaced with ABS, resulting in a coating having a mixture of FEP and ABS, which

would not satisfy the claimed limitation of a polymeric material not including a fluorocarbon resin. Thus, even this recitation is not read upon by the present claims.

Claim Rejections - 35 U.S.C. §103

Claims 1-5 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yuasa et al. (U.S. Patent No. 5,250,369) in view of Kinoshita et al. (U.S. Patent No. 5,527,638).

Applicants disagree with this rejection and traverse it, because even if the cited references were properly combined, the cited combination still would not teach suggest all the claimed elements.

Applicants have already established that Yuasa et al. does not satisfy the claimed limitation of a “aqueous polymeric material not including a fluorocarbon resin” being applied to an electrode comprised of a hydrogen alloy powder and a binding agent on a current collector. Applicants admit that Kinoshita teaches styrene-butadiene resin; however, Kinoshita et al. does not teach the aqueous resin “coating” the electrode, as asserted by the Examiner. Rather, the styrene-butadiene resin is *part of* the electrode. The styrene-butadiene resin can’t cover the electrode, because there is no electrode until the styrene-butadiene resin is put onto the underlying metal sheet. This is not an aqueous material being applied to an electrode that includes a binder; rather, it is aqueous polymeric material being applied to a metal substrate. Therefore, even if properly combined, the claimed invention is not reached.

Alternatively, if the mixture of hydrogen storage alloy and styrene-butadiene copolymer in Kinoshita et al. is equated by the Examiner as the presently claimed hydrogen absorbing alloy

powder and polymeric binding agent, then it is clear that the reference does not teach a the further claimed "aqueous polymeric material not including a fluorocarbon resin different from" the polymeric binding agent.

In view of the aforementioned remarks, Applicants submit that that the claims are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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